

REMARKS

This is in response to the Office Action mailed March 24, 2004, in which the Examiner rejected claims 1-19. Reconsideration of the application as amended is respectfully requested.

Finality of the Rejections

As a preliminary matter, Applicant believes that the Examiner has prematurely made the present Office Action final. In particular, the Examiner stated that "Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection." In accordance with MPEP 706.07(a), "second or any subsequent actions on the merits shall be final except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement . . . ." Applicant does not believe that the prior Amendment required the Examiner to perform a new search, since it does not appear that such a search was conducted. Accordingly, Applicant believes that the new ground of rejection was not necessitated by the previous amendments to the claims. Applicant, therefore, requests that the Examiner withdraw the finality of the claim rejections.

Objection to the Title

In Section 1 of the Office Action, the Examiner objected to the title of the invention as being insufficiently descriptive. Applicant has amended the title to more particularly describe the invention. Accordingly, Applicant requests that the objection be withdrawn.

Claim Rejections - 35 U.S.C. §103(a)

In Section 3 of the Office Action, the Examiner rejected claims 1-19 under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) as shown in FIG. 2 and described on pages 5-10 in view of Lairson et al. (U.S. Patent No. 5,822,153).

Applicant respectfully disagrees with the Examiner's assessment of the cited references and believes that the rejections can be withdrawn. In the Office Action, the Examiner found FIG. 2 of the cited AAPA to show a perpendicular writing element 134 "having a return pole tip, located downstream of pole 144 [main pole] relative to the rotating disc 102." Rather, as explained in Applicant's Response to the Office Action mailed June 19, 2003, the cited AAPA shows a return pole tip that is located upstream of the main pole. This is evidenced by the fact that arrow 172 of FIG. 2 of the cited AAPA represents the direction head 130 travels relative to the rotating disc 102 rather than the direction of rotation of the disc 102 [page 8, lines 19-21]. As a result, arrow 172 points in the opposite direction of the rotation of the disc 102. Therefore, the upstream direction relative to the disc 102 is the same direction as that indicated by arrow 172. Accordingly, return pole 140 is located upstream of main pole 144 relative to disc 102. Furthermore, read element 138 of FIG. 2 is located upstream of the writing element 134 of head 130.

Additionally, Applicant respectfully disagrees with the Examiner's assessment of Lairson et al. including the finding that "Lairson et al shows in figure 3 head 69 including perpendicular writing element 75 including a main pole 84 having a main pole tip and a return pole 88 having a return pole tip located downstream of pole 84 relative to rotating disc 41." In particular, Lairson et al. only describe the head 69 depicted in FIG. 3 as being "formed of a pair of pole tips 82 and 84 which are separated by an

[sic.] a magnetic gap 86, the pole tips acting as terminals of magnetically permeable yoke layers 88 and 90 which form a write circuit which is activated by an electrical current and coil layer 93." Accordingly, Applicant submits that Lairson et al. provide no basis for the Examiner's finding that the cited pole tip 84 operates as a main pole, which is located upstream of the cited return pole 88 relative to the rotating disc.

Therefore, the cited references do not disclose the head of independent claim 1. In particular, neither the cited AAPA or Lairson et al. disclose or suggest a perpendicular writing element including "a main pole . . . [and] a return pole located downstream of the main pole relative to the rotating disc", as described in claim 1. Therefore, Applicant submits that claim 1 is allowable in view of the cited AAPA, and requests that the rejection be withdrawn. Additionally, Applicant submits that claims 2-9 are allowable as being dependent from allowable base claim 1, and requests that the rejections be withdrawn.

Likewise, Applicant submits that the cited AAPA and Lairson et al. fail to disclose the head of independent claim 10. In particular, the cited art fails to disclose or suggest "a perpendicular writing element including a main pole . . . [and] a return pole located downstream of the main pole relative to the rotating disc" or "a perpendicular reading element downstream of the perpendicular writing element relative to the rotating disc", as described in claim 10. Accordingly, Applicant submits that claim 10 is allowable in view of the cited art, and requests that the rejection be withdrawn. Additionally, Applicant submits that claims 11-13 are allowable as being dependent from allowable base claim 10, and requests that the rejections be withdrawn.

Applicant further submits that neither the cited AAPA or Lairson et al. disclose or suggest the head of independent claim 14. In particular, the cited prior art fail to disclose a head

that includes "main and return poles separated by a write gap, the main pole positioned upstream of the return pole relative to the rotation of the disc", as described in claim 14. Accordingly, Applicant submits that claim 14 is allowable in view of the cited references since they fail to teach or suggest all of the claimed features, and requests that the rejection be withdrawn. Additionally, Applicant believes that claims 15-19 are allowable as being dependent from allowable base claim 14, and requests that the rejections be withdrawn.

#### New Claims

With this Amendment, Applicant has added new claims 20-23. Independent claim 20 is directed to a head that includes a writing element having "a main pole; and a return pole located downstream of the main pole relative to the rotating disc." Applicant submits that independent claim 20 is presently in condition for allowance for the reasons set forth above with regard to independent claims 1, 10 and 14. Additionally, Applicant submits that claims 21-23 are allowable as being dependent from allowable base claim 20.

#### Conclusion

In view of the above comments and remarks, Applicant believes that the present application is in condition for allowance. Reconsideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Brian D. Kaul, Reg. No. 41,885  
Suite 1600 - International Centre  
900 Second Avenue South  
Minneapolis, Minnesota 55402-3319  
Phone: (612) 334-3222 Fax: (612) 339-3312

BDK/djb